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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,547	06/05/2001	Dan Kikinis	ISURFTV139	6896

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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/875,547

Applicant(s)

KIKINIS, DAN

Examiner

Dominic D. Saltarelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 5, 2006 have been fully considered but they are not persuasive.

Factual support for the examiner's taking of official notice regarding the placement of control panels on set top boxes that have the same buttons found on a remote control device is found in US Pat. No. 5,559,549 to Hendricks et al., which teaches in col. 6, lines 38-60, that it was notoriously well known in the art to place control panels on set top boxes that have the same buttons and functions as found on a remote control device.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-8, 10-15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. (US 2004/0128685 A1, of record) [Hassell].

Regarding claims 1, 8, and 15, Hassell discloses a method (and corresponding system) comprising:

displaying an electronic programming guide on a display (figs. 5a-b);

receiving a single actuation from a user by an entertainment system and transferring a program (paragraphs 40-42) and auxiliary data (paragraphs 52-53) related to the program from a first storage device of the STB to a removable storage device (see the last sentence of paragraph 9) in response to the single actuation and without requiring the use of menus or options (paragraphs 19-21, and 81).

Hassell fails to disclose the single actuation includes a single pressing of a selected portion on a control panel of the STB.

It is notoriously well known in the art to provide set top boxes with control panels that have many of the same buttons and functionality of an associated remote control, as remote controls can be easily lost and a corresponding control panel allows a user to continue to use a set top box even without the remote control.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method, machine readable medium, and system disclosed by Hassell to include on the STB a control panel with the same buttons for actuation as is provided on the associated remote control, and would thus include the disclosed "transfer" key as found on the remote control disclosed by Hassell, providing the benefit of allowing a user to continue using the features of which the STB is capable even if the remote control is lost or misplaced.

Regarding claims 3, 10, and 17, Hassell discloses the method, machine readable medium, and system of claims 1, 8, and 15, wherein the single actuation includes a single pressing of a selected portion on a remote control apparatus (see paragraph 81, actuation of the "transfer" key on the remote control is all that is necessary to record a highlighted or active program).

Regarding claims 4, 11, and 18, Hassell discloses the method, machine readable medium, and system of claims 1, 8, and 15, wherein in response to a single actuation from the user, transferring a program and auxiliary data related to the program from the removable storage device to the first storage device of the STB (see paragraphs 9 and 81, wherein Hassell anticipates the transfer of data from one volume of storage to another [primary to secondary and vice versa] simply by pressing a "transfer" key).

Regarding claims 5, 12, and 19, Hassell discloses the method, machine readable medium, and system of claims 4, 11, and 18, and further discloses maintaining an index of programs and related auxiliary data transferred from the first storage device to the removable storage device (paragraphs 85-86).

Regarding claims 6, 13, and 20, Hassell discloses the method, machine readable medium, and system of claims 5, 12, and 19, wherein in response to a user selecting a program transferred on to the removable storage device, the

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STB prompts the user to insert the removable storage device into the STB (paragraph 89).

Regarding claims 7, 14, and 21, Hassell disclose the method, machine readable medium, and system of claims 6, 14, and 20, wherein the removable storage device is a DVD-RAM (paragraph 20).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually

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depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
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Alexandria, VA 22313-1450

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(Date)

Typed or printed name of person signing this certificate:

Signature: _____

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS



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